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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-1457

MONSANTO COMPANY, *Petitioner*

v.

ROHM & HAAS COMPANY, *Respondent*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Third Circuit

PETITION FOR REHEARING

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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PETITION FOR REHEARING

The petitioner respectfully petitions this Court for an order (1) vacating its denial of the petition for writ of certiorari, entered on June 19, 1972, and (2) granting the petition for certiorari, on the grounds stated below.

1. Developments in the Companion Litigation. Monsanto Litigation, Monsanto Company vs. Dawson Chemical Co., et al., Since Denial of Petition for Writ of Certiorari on June 19, 1972.

On July 12, 1972, Examiner Trousof of the United States Patent Office testified that she had studied the Husted report (DX-22) this spring in connection with

two meetings between herself and two attorneys for the Department of Justice. During that very recent deposition, Miss Trousof was advised, however, by a Department of Justice attorney serving as her counsel and as counsel for the Patent Office, not to testify as to what went on during such meetings concerning the patent in suit and its underlying prosecution. It is understood that such meetings and dialogue between the Examiner of the patent in this case and the Department of Justice attorneys dealt only with the factual support—or the lack of it—for the supposition of the trial court below that Examiner Trousof had been intentionally misled into granting the patent because all the data in the Husted report had not been included in the Husted affidavit.

Judge Kalodner, in his strong dissent to the decision below, details the obvious failure of respondent to sustain the burden of proving deliberate misrepresentation by Monsanto. Judge Singleton in his decision in *Monsanto* v. *Dawson Chemical, et al.* likewise made clear that there had been no proof of intentional misrepresentation in the prosecution of the application for patent. It is clear that such misrepresentation as has been held in this case has been based entirely on inference. Petitioner has now proceeded through almost every avenue of review of this matter, trusting that justice would ultimately prevail and that the absence of proof of deliberate misrepresentation would be recognized for what it is. To this point we have failed and that failure, as a result of retroactive application of this Court's decision in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation*, 402 U.S. 313 (1971), could result in overturning Judge Singleton's opinion in *Monsanto* v. *Dawson Chemical Co., et al.*

Petitioner has never considered it to be its burden to take the deposition of the examiner. But at this stage, with certiorari denied in this case and the decision here being asserted in the Houston District Court as a basis for collateral estoppel, the two cases became as one and petitioner has therefore moved to depose the examiner in order to have her testimony available for this petition and for the hearings to come in Houston in the *Dawson Chemical Co.* case.

The testimony of this experienced and competent examiner would certainly be far better evidence on the central issue of whether she had been misled by Monsanto's "withholding of certain comparative test data" than the supposition and conjecture of the trial court below in this case that she had been so misled.

Petitioner's counsel found on July 12—upon arriving at the Patent Office to take her deposition—that on July 11 Miss Trousof had been placed under specific written orders from the Department of Commerce not to answer for Monsanto any questions which would throw any light on whether her allowance of the patent had in fact been the result of her being misled.

The July 11, 1972 instruction letter to her, Plaintiff's Trousof's deposition Exhibit 2, is reprinted in the Appendix to this petition for rehearing, as is also Sec. 1701 of the Manual of Patent Examining procedure.* Miss Trousof has thus been prevented from answering questions which may, and, indeed, probably do reflect adversely on the basis for the opinion of the court be-

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* This is an official statement of the Patent Office policy against communications by examiners to persons outside the Patent Office (including other government employees) which might reflect adversely on the validity of issued patents.

low that the patent was acquired by reason of Monsanto's deliberate misrepresentation.

The Court of Appeals affirmed without even considering the foundation of the trial court's reasoning by which it held the Monsanto attorney's exercise of judgment in selecting data relevant to the unobvious differences to be a deliberate intent to defraud by reason of the omission of unselected data. The courts below have simply assumed or inferred that the Patent Office was led into error, and the Department of Commerce and the Patent Office are now attempting to prevent our laying on the record statements already made by Miss Trousof to the Department of Justice attorneys which, would throw direct light on the examiner's handling of the application, and which, it would appear, were entirely favorable to petitioner. The petitioner—and this Court—are left in the middle.

The principal basis for the trial court's holding of intentional misrepresentation by petitioner was the absence in the Husted affidavit of data showing that 3,4-DCPA (the patented chemical) and 3,4-DCAA (the prior art compound) both killed pigweed. Petitioner has urged the error of such conclusion for various reasons. But one of the most obvious arguments against any holding that such information was purposely withheld from the examiner is that such fact was, indeed, placed before the examiner in a companion Monsanto application which was explicitly cross-referenced on the first page of the application on which the patent issued. The Court of Appeals below stated that "it cannot be convincingly argued that the examiner in the Patent Office in 1967 . . . can be charged with knowledge of the content . . ." of the earlier Huffman application, despite its explicit cross-reference in

the 1967 application. Here is what Miss Trousof testified on July 12, 1972:

"Q. What did you do?

A. I ordered the files. It was difficult for me to obtain them. I finally did obtain them.

Q. Did you obtain both Serial No. 108,317 and 661,575?

A. Yes, I did.

Q. Did you review them, at least the application of each?

A. I reviewed them to the extent to see whether they would support the present application. In other words, whether this application here is entitled to the filing dates of this application." (Tr. 54-55)

The erroneous and gratuitous assumption of the court below that the examiner had not reviewed the two earlier applications containing the supposedly withheld information on pigweed is thus totally refuted.

Miss Trousof was permitted to testify that in her substantial experience as an examiner of applications claiming chemical compounds the rejection under § 103 was a very frequent one (Tr. 37-38), that affidavits commonly were submitted by applicants to traverse her initial rejection under § 103 based on a closely related chemical compound (Tr. 39, 48), that she did not, in general, have any understanding that the data in such affidavits were all the data available to the applicant (Tr. 95, 96) and perhaps, most importantly she testified that patents in this field are granted because of proven differences in properties, e.g., herbicidal properties, not because of similarities (Tr. 48).

2. Examiner Trousof Has Obviously Been Asked the Key Questions by Department of Justice Attorneys After Studying the Husted Report. Yet Petitioner Has Been Refused Answers to Questions Aimed at Determining What She Told Them.

By reason of the Commerce Department's General Counsel's letter of July 11, (see Appendix) and the repeated advice by the Justice Department's attorney representing Miss Trousof and the Patent Office during her recent deposition, petitioner has been prevented from finding out what Miss Trousof told the Justice Department attorneys.

From her testimony it is clear that Miss Trousof was given a copy of the Husted report, she was told to review that report, and she was told that she would be asked to answer certain questions based upon her review. While access to such questions and her answers have been denied petitioner, it seems clear that two of the questions were substantially as follows:

A. If all of the data in the Husted report had been before you, would you still have granted the patent?

B. Were you misled by the omission of certain data from the Husted affidavit?

CONCLUSION

These questions, and Miss Trousof's answers, go straight to the heart of the issue of intentional misrepresentation. She is the person who is alleged to have been misled, and the only one who knows if she would have acted differently. We have asked these questions, and we do not fear the answers. Petitioner, this Court and courts below to whom petitioner seeks remand as well as Judge Singleton of the Houston district court who is currently charged with resolving the

Blonder-Tongue issue of collateral estoppel in view of the current holdings in this case, would all benefit from having Miss Trousof's answers to those questions. This Court is requested to reconsider its order denying certiorari and to grant certiorari for the purpose of considering the remand of the case to the Courts below with instructions to obtain the testimony of the examiner relative to whether she was misled into granting the patent and whether, if she had had the entire Husted report in 1967, she would have granted the patent.

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Certificate of Counsel

As counsel for the petitioner, I hereby certify that this petition is presented in good faith and not for delay and is restricted to the grounds specified in Rule 58(2).

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Counsel for Petitioner

APPENDIX

APPENDIX A

GENERAL COUNSEL OF THE DEPARTMENT OF COMMERCE
WASHINGTON, D. C. 20230

Ms. Natalie Trousof
Group 120
U.S. Patent Office
Washington, D. C. 20231

Dear Ms. Trousof:

I have been informed that a subpoena has been issued for your testimony in connection with matters relating to the U.S. patent of Huffman, No. 3,382,280, issued May 7, 1968, and related patent applications. You are hereby instructed that, in such testimony, you are not to answer any questions of the following types:

1. Questions respecting the decision to issue that patent which do not relate to relevant matters of fact or which go to the bases or reasons for such decision or your mental processes, analyses, or conclusions in making such decision.

2. Questions as to whether specified evidence not available to you at the time of the said decision would have then been or is now deemed by you to be pertinent or material to the question of patentability of the claims of the identified patent.

3. Questions as to whether specified evidence not available to you at the time of the said decision would, if then available, have affected the decision.

This instruction is issued in conformance with Section 7.05 of Department Administrative Order 205-12, and pursuant to written delegation of authority from the Secretary of Commerce.

/s/ WILLIAM N. LETSON
General Counsel

July 11, 1972

THE SECRETARY OF COMMERCE
WASHINGTON, D. C. 20230

Delegation of Authority

Pursuant to the authority vested in me as Secretary of Commerce, by Section 301 of Title 5, United States Code and Section 2 of Reorganization Plan No. 5 of 1950 (64 Stat. 1263), I hereby delegate to the General Counsel of the Department of Commerce the functions and responsibilities under Section 7 of the Department Order 205-12, as amended, with respect to final determinations concerning

> appearance by an officer or employee of the Department as a witness to testify on behalf of or at the request of any party other than the United States Government in any court or other proceeding either because of his official capacity or of his possession of knowledge gained in an official capacity

that is sought by subpoena, order or other compulsory process or other demand of a court or other authority.

/s/ PETER G. PETERSON
Secretary of Commerce

July 11, 1972

Manual of Patent Examining Procedure

Chapter 1700 Miscellaneous

1701 Examiners Not To Express Opinion on Validity Nor Testify as Patent Experts [R-21]

Inasmuch as public policy does not permit Examiners to decide, as judges in the Patent Office, questions upon which they have been retained to give opinions as expert witnesses in patent cases in the courts, every Examiner who shall testify as an expert in a patent case pending in any court will be dismissed, unless he shall have so testified involuntarily, upon compulsion by competent judicial authority, and without retainer or preparation.

Congress, in 35 U.S.C. 282, has endowed every patent granted by the Patent Office with a presumption of validity. Public policy demands that every employee of this Office refrain from expressing to any interested person any opinion or view as to the invalidity of any U.S. Patent. The question of validity or invalidity is exclusively a matter for the courts to determine. Each member of the Examining Corps is cautioned to be especially wary of any inquiry from any person outside the Patent Office (including any employee of another government agency), the answer to which might indicate that a particular patent should not have been issued.

Whenever an Examiner is asked or subpoenaed to testify in a suit concerning a patent, trademark registration, or application for either, he is directed to report that fact *immediately* to the Solicitor.

Examiners are cautioned against answering inquiries from any person outside the Patent Office as to whether or not a certain reference was considered and, *a fortiori*, whether or not a claim would have been allowed over that reference. This applies to anything in the patented file, including the extent of the field of search and any entry relating thereto. The record of a patented file must speak

for itself. Practitioners can be of material assistance in this regard by refraining from making such inquiries of members of the Examining Corps. Answers to inquiries of this nature must of necessity be refused, and such refusal should be considered neither discourteous nor an expression of opinion as to validity.

Also, Examiners are reminded that, in view of the long established policy of the Patent Office to refuse to permit members of the staff of the Patent Office to testify in patent suits, they should, before allowing an application, determine that the written record is accurate and complete.